

REMARKS/ARGUMENTS

After entry of the foregoing amendment, claims 8-13 will be pending. The claims have been amended to correct an inadvertent typographical error (*i.e.*, omission of a conjunction and misspelled word). No new matter has been added.

Information Disclosure Statement

The Office Action indicated that reference BK was not in proper format. Applicants submit a Communication under separate cover to address this issue.

Rejections under 35 U.S.C. § 112

Claims 8 and 11-13 stand rejected under 35 U.S.C. §112, first paragraph, with respect to alleged “lack of conjunction” in Applicants’ recital of 2’-modifications (Office Action at page 3). Applicants have followed the Examiner’s suggestion and have amended claim 8 to insert the word “or” before “alkyl” in line 3, thereby obviating the rejection. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 8-13 stand rejected under 35 U.S.C. §112, first paragraph, because the specification allegedly does not describe any oligonucleotides that have “at least two different 2’-substitutions, wherein said different substitutions are selected from halo, azido, amino, alkoxy, thioalkoxy, alkylamino, and alkyl” (*id.*). Applicants request reconsideration, and direct the Examiner’s attention to Example 13 on pages 63-64, and specifically to page 64, lines 5-8 which disclose oligonucleotides comprising both 2’-deoxy-2’-methylthio (*i.e.*, 2’-thioalkoxy) and 2’-deoxy-2’-O-methyl (*i.e.*, 2’-alkoxy) substituents. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection under 35 U.S.C. §102

Claims 8-13 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,612,215 to Draper et al. (the "Draper patent"). This rejection is based on the Examiner's refusal to acknowledge Applicants' claim of priority in view of the rejections under 35 U.S.C. §112. As discussed above, the present specification has sufficient written description support for the claimed inventions.

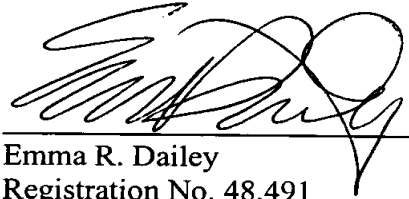
Moreover, Applicants had possession of the claimed invention as of a date earlier than the earliest effective filing date of the Draper patent. For example, pages 52-53 of priority application serial no. 07/835,932, filed March 5, 1992, disclose oligonucleotides that comprise at least two different 2'-substitutions, wherein said different substitutions are selected from halo, azido, amino, alkoxy, thioalkoxy, alkylamino, and alkyl. Accordingly, Applicants respectfully request reconsideration and acknowledgment of the claim of priority and reconsideration and withdrawal of the rejection, as the Draper patent is not a proper reference under Section 102(b).

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PATENT

Applicants submit that the foregoing constitutes a complete response and a *bona fide* attempt to advance prosecution. The undersigned invites the Examiner to contact her at the number below should there be any questions.

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